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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,876	03/30/2001	Didier Wilhelm	2000FR303	6765

7590 09/06/2002

CLARIANT CORPORATION
Industrial Property Department
4331 Chesapeake Drive
Charlotte, NC 28216

EXAMINER	
BERMAN, SUSAN W	
ART UNIT	**PAPER NUMBER**
1711	5

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MS 5

Office Action Summary	Application No.	Applicant(s)	
	09/821,876	WILHELM ET AL.	
	Examiner	Art Unit	
	Susan W Berman	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7, 8 and 11 are rendered indefinite by the use of the word "type". It is not clear whether applicant intends to claim alkoxylated (meth)acrylate or another monomer of the same type. Claim 12 is indefinite because it fails to clearly state what the "desired quantity and grade " of silica are, what the "chosen quantity" of vinyl silane is, what the "desired quantity " of (meth)acrylic monomer is. It is suggested that applicant change "characterized by the fact that" to "wherein", throughout the claims. It is noted that claim 1 recites that the compositions are polymerizable thermally and by radiation, while claims 15 and 16 recite polymerization by radiation or thermally.

Claims 15 and 16 provide for the use of the compositions of claim 1, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

Claims 15-16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacquinot et al (JP 11-246789, FR 2772777, EP 0 926 170 A1 or equivalent US 6,136,912) in view of Swofford (4,822,828). Jacquinot et al disclose and claim silico-acrylic fluid compositions comprising silica, vinylsilane and tripropylene glycol diacrylate as multifunctional acrylic monomer. The compositions contain less than 1.5%, preferably 1.2% water. The limitations set forth in the instant dependent claims are taught by Jacquinot et al.

Swofford discloses radiation curable coating compositions comprising a partial condensate of colloidal silica and a vinyl silane, a multifunctional acrylate and a photoinitiator. The multifunctional acrylates taught include tripropylene glycol diacrylate and ethoxylated trimethylolpropane triacrylate, which is a preferred monomer (column 6, lines 52-68). Swofford teaches that monomers that do not create stability or viscosity problems are selected, that triacrylates are preferred and water-soluble triacrylates are more preferred due to lower initial haze (column 6, lines 43-51).

It would have been obvious to one skilled in the art to substitute for or include ethoxylated trimethylolpropane diacrylate for or with tripropylene glycol diacrylate in the compositions disclosed by Jacquinot et al, as taught by Swofford in analogous art. One of ordinary skill in the art at the time of the invention would have been motivated to do so because Swofford teaches that each of tripropylene glycol diacrylate and ethoxylated trimethylolpropane diacrylate are suitable multifunctional acrylate monomers in coating compositions containing silica treated with a vinylsilane. Swofford provides additional

motivation to include the ethoxylated monomer by teaching that it is a preferred monomer in the disclosed compositions.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c).

For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). The instant application was filed in the U.S. after November 29, 1999, however, there is no evidence of record to show common ownership at the time the invention was made.

Double Patenting

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,136,912 in view of Swofford (4,822,828). The major difference between the claims of US '912 and the instant claims is that the multifunctional acrylate monomer in the claims of US '912 is tripropylene glycol diacrylate, while the

multifunctional acrylate monomer in the instant claims is an alkoxylated (meth)acrylate. Swofford, as discussed above, teaches that either trimethylolpropane diacrylate or ethoxylated trimethylolpropane triacrylate are suitable multifunctional (meth)acrylate monomers in compositions comprising a silica/vinyl-functional silanol dispersion. Swofford teaches that monomers that do not create stability or viscosity problems are selected, that triacrylates are preferred and water-soluble triacrylates are more preferred due to lower initial haze (column 6, lines 43-51).

It would have been obvious to one skilled in the art to substitute for or include ethoxylated trimethylolpropane diacrylate for or with tripropylene glycol diacrylate in the compositions disclosed by Jacquinot et al, as taught by Swofford in analogous art. One of ordinary skill in the art at the time of the invention would have been motivated to do so because Swofford teaches that each of tripropylene glycol diacrylate and ethoxylated trimethylolpropane diacrylate are suitable multifunctional acrylate monomers in coating compositions containing silica treated with a vinylsilane. Swofford provides additional motivation to include the ethoxylated monomer by teaching that it is a preferred monomer in the disclosed compositions.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.

Susan Berman

Susan W Berman

Primary Examiner

Art Unit 1711

SB
September 1, 2002